

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

008895-0325352

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/564,730

Filed

June 22, 2006

First Named Inventor

WILLEM PETER BLOKPOEL

Art Unit

3727

Examiner

WILSON, Lee D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

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assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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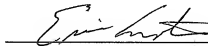
attorney or agent of record.

Registration number 54,806

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

Eric B. Compton

Typed or printed name

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Telephone number

November 20, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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A. ATTACHMENT SHEETS TO PRE-APPEAL BRIEF CONFERENCE REQUEST

Mail Stop AF  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that a panel of examiners formally review the legal and factual basis of the rejection in the above-identified application prior to the filing of an appeal brief. Appellant asserts that the outstanding rejection (now on appeal by virtue of the concurrently filed Notice of Appeal) is clearly improper based both upon errors in facts and the omission of essential elements required to establish a *prima facie* rejection (i.e., the prior art references fail to disclose, teach or suggest all the recited claim features).

APPEALED REJECTION

Appellant is appealing the rejection of claims 1 and 3-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,558,178 to Hoover *et al.* ("Hoover").

ARGUMENTS FOR TRAVERSAL

The rejection is improper for at least the reasons that (i) The Final Office Action fails to establish a *prima facie* case of anticipation, and (ii) Hoover fails to disclose each and every feature recited by each of independent claims 1, 9 and 13. Appellant will address each of these arguments below.

**I. The Final Office Action fails to establish a *prima facie* case of anticipation.**

Under 35 U.S.C. § 102, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "In order to demonstrate anticipation, the proponent must show "that the four corners of a single, prior art document describe

every element of the claimed invention.” See *Net Money/IN (NMI) v. VeriSign et al*, Slip Op. pg. 14 (Fed. Cir. October 20, 2008) (quoting *Xerox Corp. v. 3Com Corp.*, 458 F.3d 1310, 1322 (Fed. Cir. 2006)) (emphasis added)).

The Final Office Action fails to properly provide an explanation as to how the Hoover applied reference allegedly discloses or teaches all of the claimed subject matter of, for example, rejected claims 1 and 3-20. Rather, the Final Office Action attempts to address all of pending claims 1 and 3-20 with a brief one-paragraph explanation. [See Final Office Action, pg. 2]. Appellant submits that the this treatment of the claims is improper. See 37 C.F.R. §1.104(c)(2) (“When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”); *Ex parte Rozzi*, 63 USPQ2d 1196, 1200 (BPAI 2002) (Board refuses to adjudicate where examiner’s work is incomplete); *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000) (“The examiner has left applicant and the Board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess.”); *Ex parte Braeken*, 54 USPQ2d 1110, 1113 (BPAI 1999) (appeal is “not ripe” because of omissions by examiner). Indeed, “[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” MPEP § 707.07(d).

More particularly, the Final Office Action fails to show how Hoover allegedly teaches “*a fiber layer impregnated with a polishing product*,” as recited in independent claims 1, 9 and 13. Similarly, the Final Office Action fails to show how Hoover allegedly teaches “... *wherein the polishing implement comprises an impermeable layer to which the sachet is attached to the structure, the impermeable layer having a surface greater than the sachet*,” as recited in dependent claims 3 and 15. These are just a few examples of the Final Office Action failure to address several claim limitations altogether.

In Appellant’s Request for Reconsideration dated September 26, 2008, Appellant traversed this rejection and provided similar arguments for why the rejection was improper and should be withdrawn. However, the Advisory Action mailed October 10,

2008, selected a checkbox noting “The proposed amendment(s) filed after the final rejection, but prior to the date of filing a brief, will not be entered because: ... (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issued for appeal.” [PTOL-303: box 3(c): emphasis in original]. Appellant submits this form paragraph is inappropriate, since the Request for Reconsideration did not attempt to amend the claims. Notwithstanding this deficiency, the Advisory fails to address Appellant’s arguments altogether, and further indicates that claims 1 and 3-20 stand rejected. [See PTOL-303: box 7]. This is improper. “*Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.*” MPEP § 707.07(f) (emphasis added).<sup>1</sup>

Accordingly, Appellant submits that a *prima facie* case of anticipation has not been established.

## **II. Hoover fails to teach each and every feature of the claimed invention.**

Appellant submits that Hoover fails to teach a polishing implement for polishing a shoe comprising, *inter alia*, a removable sachet provided on or to be provided on the structure that covers the first polishing layer at least partly, so that only after removal of the sachet, the first polishing layer is completely revealed; and the sachet comprising: a fiber layer impregnated with a polishing product forming a second polishing layer; and a protective layer; wherein, in a closed condition, the second polishing layer is covered by the protective layer, and while, in an opened condition, the second polishing layer is exposed for applying the polishing product to the shoe, as recited in claim 1; or a sachet provided on or to be provided on the structure, the sachet comprising: a fiber layer impregnated with a polishing product forming a second polishing layer; and a protective layer; wherein, in a closed condition, the second polishing layer is covered by the protective layer, and while, in an opened condition, the protective layer is folded back and the second polishing layer is exposed for applying the polishing product to the shoe, as recited in claim 13. Similarly, Appellant submits that Hoover fails to teach a

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<sup>1</sup> The Final Office Action applied a new grounds of rejection based on the newly cited Hoover reference, which Appellant previously did not have the opportunity to address. [See Final Office Action, pg. 2, ¶¶ 3-4].

sachet for a polishing implement comprising, *inter alia*, a fiber layer impregnated with a polishing product forming a polishing layer; and a protective layer, wherein, in a closed condition, the polishing layer is covered by the protective layer, and while, in an opened condition, the protective layer is folded back and the polishing layer is exposed for applying the polishing product to the shoe, as recited in claim 9.

The term “sachet” as used in the present application (Appellant is acting as his own lexicographer) refers expressly in the claims to a two-part structure that includes 1) a fiber layer impregnated with a polishing product forming a polishing layer, and 2) a protective layer, wherein, in a closed condition, the polishing layer is covered by the protective layer, and while, in an opened condition, the protective layer is folded back and the polishing layer is exposed for applying the polishing product to the shoe.

Hoover does not teach a sachet, nor a polishing implement that includes a sachet. Rather, Hoover discloses a *sanding* glove for sanding a work piece such as wood. [See Hoover, col. 1, lines 6-7]. Moreover, the features of Hoover which are relied upon by the Final Office Action, i.e., *sanding* pad 208, *sandpaper* 220, and segments of *sandpaper* 350, are sanding implements which are wholly inappropriate for polishing shoes. Indeed, sanding and polishing implements and processes are entirely different. Sanding shoes, for example, with the sanding glove disclosed by Hoover would scuff, mar and/or scratch the shoe material rendering the shoe unattractive. By contrast, applying a polishing product to the shoe is used for making the shoes look “new” and more aesthetically pleasing. For at least these reasons, Appellant submits that one skilled in the art would not consider the *sanding glove* of Hoover a polishing implement for polishing a shoe.<sup>2</sup>

Notwithstanding this deficiency, Hoover also fails to teach *a fiber layer impregnated with a polishing product for applying the polishing product to the shoe forming a polishing layer*. For example, Hoover makes no mention or suggestion of a

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<sup>2</sup> During examination, the claims are to be given their broadest reasonable interpretation consistent with the specification. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

polishing product (e.g., shoe polish), much less impregnating the glove 100 (or any other element) with a polishing product.

Even if the Examiner incorrectly equates the sanding material to the fiber layer (which would be incorrect), there is absolutely no disclosure whatsoever in Hoover of a *protective layer*, wherein, in a closed condition, the polishing layer is covered by the protective layer, and while, in an opened condition, the protective layer is folded back and the polishing layer is exposed for applying the polishing product to the shoe. Rather, in the sanding pads 208 of Hoover, the abrasive-sanding surface is always exposed.

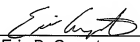
There is no such sachet in Hoover. Accordingly, Hoover fails to disclose each and every feature recited by each of independent claims 1, 9 and 13.

For at least the foregoing reasons, the rejection of each of independent claims 1, 9 and 13 is improper and should be withdrawn. Dependent claims 3-8, 10-12, and 14-20 are patentable because they depend from claims 1, 9 and 13, respectively, for at least the reasons discussed above related to claims 1, 9 and 13, as well as for the additional features they recite. Accordingly, the rejections of claims 1 and 3-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by Hoover should be withdrawn and the claims be allowed.

#### CONCLUSION

Therefore, it is respectfully requested that the panel return a decision concurring with Appellant's position and eliminating the need to file an appeal brief because there are clear legal and/or factual deficiencies in the appealed rejections.

Respectfully submitted,  
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